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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,167	02/05/2002	Terrance D. Peabody	IOI-389	8049
45488	7590	03/29/2005		
WILLIAMS, MORGAN & AMERSON, P.C./ZIMMER 10333 RICHMOND, SUITE 1100 HOUSTON, TX 77042			EXAMINER MARMOR II, CHARLES ALAN	
			ART UNIT 3736	PAPER NUMBER

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/068,167	Applicant(s) PEABODY ET AL.	
	Examiner Charles A. Marmor, II	Art Unit 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-10,12-26,28-30 and 32-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,10,12-26,28,30 and 32-38 is/are rejected.
- 7) ☒ Claim(s) 8,9 and 29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 10, 2005 has been entered.

The Examiner acknowledges the amendments to claims 1, 3-5, 10, 16-19, 30, 32 and 35; the cancellation of claims 2, 11 and 31; and the addition of new claims 36-38. Claims 1, 3-10, 12-26, 28-30 and 32-38 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 12-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 12 is dependent on claim 11, which has been canceled via the Amendment filed January 10, 2005.

Claim Rejections - 35 USC § 102

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 19-26, 28, 30, 32 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Hodge ('178). Claims 19-26, 28 and 29 of the present application include the transitional phrase "comprising" which is inclusive or open-ended and does not exclude additional, unrecited method steps; and furthermore, the claim language does not require the claimed method steps to be performed in any particular order. Hodge teaches a method for utilizing a measuring device to facilitate an orthopedic procedure. The device includes a marking guide **94**; a stop plate **50**; a ruler **100** coupled to the marking guide and to the stop plate; and a locking mechanism at lock screw **46** that cooperates with the ruler to permit selective adjustment of the distance between the marking guide and the stop plate by moving the stop plate with respect to the ruler. The marking guide and the stop plate are themselves noninvasive, and therefore are capable of being utilized in a manner noninvasive to the bone tissue. The method includes the steps of setting a selected distance between a noninvasive stop plate and a noninvasive marking guide movably coupled to the stop plate by changing the position of the stop plate relative to the marking guide along a ruler by changing the position of the marking guide along a ruler by moving the stop plate with respect to the ruler; abutting the noninvasive stop plate against an end of a member to be measured; placing the noninvasive marking guide along bone tissue of the member the selected distance from the stop plate for marking of the bone tissue; marking the bone tissue; and lifting the noninvasive stop plate and the noninvasive marking guide from the

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member. The bone tissue may be removed from the member in an oncological procedure or by performing a revision procedure. The noninvasive stop plate may be pivoted to a desired angle that allows it to abut a pair of distal femoral condyles of the member. The stop plate alternatively may abut the proximal end of a tibia.

6. Claims 1, 3-7, 10, 16-18, 30 and 32-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Cosbie ('146). Cosbie teaches a measurement member that is capable of assisting in locating a prosthetic device during an orthopedic procedure. The measurement member includes a marking guide **2**; a stop plate **3**; a ruler **A** coupled to the marking guide and to the stop plate; and a locking mechanism at clamp **4** that cooperates with the ruler to permit selective adjustment of the distance between the marking guide and the stop plate by moving the stop plate with respect to the ruler **A**. The marking guide and the stop plate are noninvasive, and therefore are capable of being utilized in a manner noninvasive to the bone tissue. The claim language does not define any particular structure characteristic of the respective marking guide and stop plate; therefore, since surface **2** is capable of guiding marking of a bone member and since plate **3** is capable of being used as a stop member, these elements meet the claim limitations. The stop plate is pivotably coupled to the locking mechanism to permit positioning of the stop plate at desired angles with respect to the ruler (see Figure 1). The stop plate is configured such that it is capable of abutting the distal femoral condyles or the proximal end of a tibia. The stop plate may be locked at desired angles with respect to a pivot point on the ruler at clamp **4**. The desired angles are inclusive of approximately 84°, 90° and 96°. The locking mechanism includes an

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opening and ruler portion A is configured to slide within the opening. Release mechanism 4 selectively releases the ruler for sliding movement through the opening.

7. Claims 10, 16, 17, 30, 32 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Knebelman ('850). Knebelman teaches a measurement member that is capable of assisting in locating a prosthetic device during an orthopedic procedure. The measurement member includes a marking guide 19; a stop plate 23; a ruler 11 coupled to the marking guide and to the stop plate; and a locking mechanism at clamp 27 that cooperates with the ruler to permit selective adjustment of the distance between the marking guide and the stop plate by moving the stop plate with respect to the ruler 11. The marking guide and the stop plate are noninvasive, and therefore are capable of being utilized in a manner noninvasive to the bone tissue. The claim language does not define any particular structure characteristic of the respective marking guide and stop plate; therefore, since surface 19 is capable of guiding marking of a bone member and since plate 23 is capable of being used as a stop member, these elements meet the claim limitations. The stop plate is pivotable with respect to the ruler when the screw 27 does not extend into slot or groove 29. The stop plate is configured such that it is capable of abutting the distal femoral condyles or the proximal end of a tibia. The ruler is a rigid member that extends the full length between the marking guide and the stop plate.

8. Claims 1, 3-6, 10, 16-18, 30, 32 and 36-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Gilmer ('290). Gilmer teaches a measurement member that is capable of assisting in locating a prosthetic device during an orthopedic procedure. The measurement member

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includes a marking guide **B**; a stop plate **D**; a ruler **C** coupled to the marking guide and to the stop plate; and a locking mechanism at clamp **E,F** that cooperates with the ruler to permit selective adjustment of the distance between the marking guide and the stop plate by moving the stop plate with respect to the ruler **C**. The marking guide and the stop plate are noninvasive, and therefore are capable of being utilized in a manner noninvasive to the bone tissue. The claim language does not define any particular structure characteristic of the respective marking guide and stop plate; therefore, since surface **B** is capable of guiding marking of a bone member and since plate **D** is capable of being used as a stop member, these elements meet the claim limitations. The stop plate is pivotably coupled to the locking mechanism to permit positioning of the stop plate at desired angles with respect to the ruler (see Figure 2). The stop plate is configured such that it is capable of abutting the distal femoral condyles or the proximal end of a tibia. The stop plate may be locked at desired angles with respect to a pivot point on the ruler at clamp **E,F**. The desired angles are inclusive of approximately 84°, 90° and 96°.

Allowable Subject Matter

9. Claims 8, 9 and 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claims 12-15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 8 and 9, no prior art of record teach or fairly suggest a measuring guide for assisting in locating a prosthetic device, as claimed by Applicant in claim 7, where the ruler includes a flat side and a series of periodic grooves formed thereon and the release mechanism includes at least one protrusion to engage selected grooves of the series of grooves.

Regarding claims 12-15, no prior art of record teach or fairly suggest a measuring guide for noninvasive measurement of bone tissue, as claimed by Applicant in claim 10, where the locking mechanism includes a block with an opening for slidably receiving the ruler and a spring-loaded release mechanism biased toward engagement with the ruler to lock the position of the ruler with respect to the lock.

Regarding claim 29, no prior art of record teach or fairly suggest a method for utilizing a measuring device to facilitate an orthopedic procedure, as claimed by Applicant in claim 28, where the setting step includes selectively locking the noninvasive stop plate to the ruler with a spring biased release mechanism.

Response to Arguments

12. Applicant's arguments with respect to the rejection of claims 1, 7, 30, 32 and 33 as being anticipated Gerhardt ('162); the rejection of claim 10 as being anticipated by Malek Afzali ('163); the rejection of claims 1-7, 10, 11, 16-18 and 30-35 as being anticipated Ferrante et al. ('401); the rejection of claims 8 and 9 as being unpatentable over Gerhardt in view of Kim ('891); and the rejection of claims 8, 9 and 12-15 as being unpatentable over Ferrante et al. in

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view of Doherty et al. ('545) have been considered but are moot in view of the new ground(s) of rejection. Applicant contends that Gerhardt fails to teach or suggest a measuring guide or device that includes a pivotable stop plate. Applicant contends that Malek Afzali fails to teach or suggest a measuring guide that includes a noninvasive stop plate that is coupled to the ruler and is "pivotable, with respect to a pivot point on the ruler." Applicant contends that Ferrante et al. fail to teach or suggest a ruler that indicates the distance between the marking guide and the stop plate. These arguments have been considered but are moot in view of the new grounds of rejection citing Cosbie, Gilmer, or Knebelman as set forth hereinabove.

13. Applicant's arguments filed January 10, 2005 have been fully considered but they are not persuasive. Applicant contends that Hodge fails to disclose a measuring guide where the ruler indicates the distance between the means for abutting and the means for guiding or a method including the step of reading from the ruler the distance between the noninvasive stop plate and the noninvasive marking guide. Applicant points to column 5, lines 24-26 of the patent which disclose the scale indicates available sizes of femoral knee prostheses in support of this argument. This argument is not persuasive. The Examiner respectfully contends that although the units of measurement on the scale are not units of measurement generally associated with a distance measurement (e.g., centimeters, inches, or the like), these units of measurement disposed on the scale (100) when considered in respect to the indexing mark (102) clearly are representative of the distance between the means for abutting and the means for guiding marking. In view of the foregoing, the rejections of claims 19-26, 28, 30, 32 and 33 have been maintained. However, the rejections of independent claims 1, 7, 10, 11, 16 and 17 as anticipated

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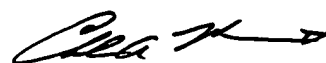
by Hodge have been withdrawn since Hodge fails to teach or suggest a stop plate pivotably coupled to the locking mechanism or a stop plate that is pivotable with respect to a pivot point on the ruler.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Marmor, II whose telephone number is (571) 272-4730. The examiner can normally be reached on M-TH (7:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charles A. Marmor, II
Primary Examiner
Art Unit 3736

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March 18, 2005